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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/569,339	11/07/2006	Renke Bargmann	101769-341 KGB	3129
27384 7590 11/26/2008 NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD AVENUE 18TH FLOOR NEW YORK, NY 10022			EXAMINER TRAIL, ALLYSON NEEL	
			ART UNIT 2876	PAPER NUMBER
			MAIL DATE 11/26/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/569,339	Applicant(s) BARGMANN ET AL.	
	Examiner ALLYSON N. TRAIL	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Continuation Data

1. This application is a national stage entry of PCT/EP04/09345, filed August 20, 2004.

Information Disclosure Statement

2. The Information Disclosure Statement filed on February 22, 2006 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1-5, 8, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Singh et al (6,210,522), hereinafter Singh.

With respect to claims 1 and 12, Singh illustrates in figures 1 and 3, a method comprising bonding a chip module 54, in a card body with an adhesive including at least two adhesive layers (10) and (12). Column 5, line 61 – column 6, line 7 disclose that the at least two layers (10) and (12) of the adhesive film differ chemically from one another (thermoplastic film and thermoset film).

With respect to claim 2, Singh teaches in column 6, lines 1-4, that the adhesive layers 10 and 12 are pressure sensitive adhesives.

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With respect to claims 3 and 4, Singh discloses in the abstract that the first layer 10, exhibits high bonding compatibility with epoxy materials – specifically a thermoplastic polymer. Singh later teaches in column 2, lines 59-60, that the second layer 12, exhibits high bonding compatibility with a phenolic polymer.

With respect to claim 5, Singh teaches in claim 7, that the thermoplastic is based on polyesters.

With respect to claim 8, Singh teaches in column 6, lines 8-15 that the layer 12 may be based on heat-activatable systems.

With respect to claims 10 and 11, Singh illustrates in figure 3 an additional carrier layer 54 for holding the chip 16.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singh in view of Schuhmacher et al (2003/0085380), hereinafter Schuhmacher.

Singh's teachings are discussed above. Singh however fails to specifically teach the second layer being based on synthetic rubber.

With respect to claims 6, 7, and 9, Schuhmacher discloses in paragraph 0006 examples of adhesives, such as synthetic rubber which is based on a polyurethane.

In view of Schuhmacher's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use specifically a synthetic rubber as the adhesive layer taught by Singh. One would be motivated to use synthetic rubber for its known qualities of durability and low cost.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Ando et al (2007/0184290).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is (571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (571) 273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**allyson.trail@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published

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in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG

89.

/Allyson N. Trail/
Allyson N. Trail
Patent Examiner
Art Unit 2876

November 22, 2008